

REMARKS

Claims 1, 3-7, 9-12, 14-18, and 20-22 were rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Official Action asserts that the claimed invention lacks a practical application because the claimed invention fails to produce a tangible result, and more specifically because the presentation of a system performance prediction remains in the abstract and fails to have real world value. Reconsideration and withdrawal of the rejection are respectfully requested.

As explained in the PTO Guidelines for Subject Matter Eligibility (November 22, 2005), in order to satisfy Section 101 requirements, the claim must be for a practical application of the Section 101 judicial exception, which can be identified in various ways, one of which is that the claimed invention produces a useful, concrete and tangible result.

For an invention to be "useful" it must satisfy the utility requirement of Section 101. The Official Action implicitly acknowledges that this requirement has been met.

Another consideration is whether the invention produces a "concrete" result. The process must have a result that can be substantially repeatable or the process must substantially produce the same result again. The Official Action also implicitly acknowledges that this requirement has been met.

The "tangible" requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a Section 101 judicial exception, in that the process claim must set forth a practical application of that Section 101 judicial exception to produce a real-world result. "[A]n application of a law of nature or mathematical formula to a . . . process may well be deserving of patent protection." *Diehr*, 450 U.S. at 187, 209 USPQ at 8; see also *Corning*, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 ("It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . ."). In other words, the opposite meaning of "tangible" is "abstract."

The tangible result provided by the claims is the presentation of the system performance prediction. The presentation of a system performance prediction is practical real-world result that allows the system designer to determine whether the system design is adequate. The Official Action asserts that the presentation of a system performance prediction is "in the abstract." It is not clear what is meant by this phrase since there is nothing "abstract" about presenting a system performance prediction; the presentation tells the user how the system is expected to perform - e.g., above or below

average, 6 on a scale of 10, etc. A prediction of system performance is presented as a fact that is usable by the system designer to re-design or adjust the system whose performance is being predicted. As one of skill in the art will appreciate, comparing system performance predictions presented before and after re-designing or adjusting the system will indicate whether the re-design or adjustment has been effective. Presentation of a system performance prediction is a very valuable real-world tool.

The Official Action also indicates that the specification is silent regarding a means of presenting the system performance prediction. (Please note that it is not clear to the undersigned whether this is being asserted as a basis for the rejection as this discussion in paragraph 2.3 of the Official Action is not included in the rejection that begins in paragraph 3.) In any event, the method or device by which the system performance prediction is presented is clearly known to those of skill in the art and need not be disclosed. One of skill in this art is presumed to have certain computer basic skills, and one of the basic skills is presentation of results. As the artisan will appreciate, the system performance prediction may be presented on a screen, in print form, or other suitable format. To assert that one of skill in the art will understand all of the other complicated parts of the present invention, but not know how to present the results trivializes the patent application process.

The application is written for one of skill in the art and need not include that which is known.

Accordingly, the claims avoid the rejection under 35 U.S.C. 101.

The comment in the Official Action (paragraph 3 on page 3) that the statement on page 15, lines 18-19 of the specification is an ineffective attempt to incorporate the reference document has been noted. The statement on page 15, lines 18-19 is not an attempt to incorporate the reference document.

The withdrawal of the previous rejections under §102 and §103 is noted with thanks. The statement that the indication of allowable subject matter is being held in abeyance pending resolution of the 35 U.S.C. 101 rejection is indicative of an improper piece-meal examination.

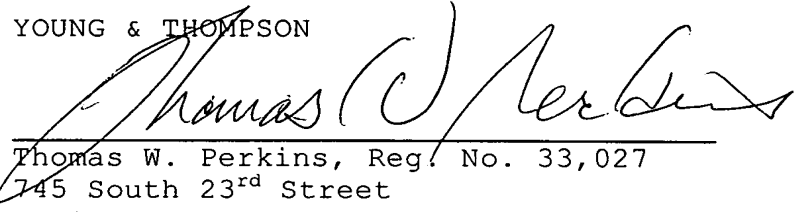
In view of the foregoing remarks, it is believed that the present application is in condition for allowance. Reconsideration and allowance are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any

overpayment to Deposit Account No. 25-0120 for any additional
fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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